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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,665	10/15/1998	WATURA ITO	2091-0169P-S	9578

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EXAMINER

HARRIS, TIA M

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/29/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/172,665

Applicant(s)

ITO, WATURA

Examiner

Tia M Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The applicant's amendment to claim 5 has overcome the objection to the claim. Therefore, the objection is withdrawn.

Response to Arguments

1. Applicant's arguments filed 6/30/03 have been fully considered but they are not persuasive. Applicant argues that the Ota and Shintani references do not teach or suggest a format conversion means for converting the format of the digital image signal into a predetermined format used in a digital camera separate from the digital image generation means. The examiner respectfully disagrees with this assessment of the references. Specifically, the examiner relies on the teaching of Ota to teach this format conversion process. Ota teaches film scanner (11) that reads out image data on film and generates a digital image signal representing the image (see Constitution, Line 1). The digital image signal then goes through image data characteristic conversion and color correction, and is JPEG compressed and written on a mini disk, the JPEG compression being the format used by the digital camera. That is, the digital image signal is converted to the predetermined format (JPEG) that is the format used in the digital camera, which is separate from the film scanner (see Constitution, Lines 3-6). The image signal is then recorded on the mini disk (MD) in this format (JPEG) (see Constitution, Lines 3-4). Image data that is to be used by the digital camera is checked to make sure that it is JPEG compressed, and if not, compression is canceled (see the Constitution). That is, the format conversion means converts the digital image data into JPEG compressed data which is the predetermined format to be used by the digital camera that is separate from the film scanner.

Applicant further argues that not all digital cameras can read JPEG files, and therefore it is not inherent that JPEG files can be used in digital cameras. Respectfully, the examiner is not

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stating that all digital cameras use JPEG format. As stated in the previous office action, the predetermined format for the digital camera in the Ota reference is JPEG, and this is inherent since a step is performed that checks when the image data of the camera is not in that format (see Constitution, Lines 5-6). That is, it is inherent for the camera in the Ota reference to use the JPEG format, not all digital cameras in general. Furthermore, the fact that JPEG files are not used in all digital cameras does not negate the fact that JPEG can be used as taught by the reference.

Applicant further argues that Shintani does not teach or suggest providing a recording medium that contains a digital image signal in a predetermined format, which can be loaded in a digital camera. The examiner respectfully points out that the teaching of Shintani is used to illustrate that recording mediums such as a recording disk can be loaded into a digital camera. Therefore, it would have been obvious that after the digital image signal of Ota has been converted and stored in the recording medium (disk), the disk could be loaded in the digital camera as taught by Shintani.

For at least the reasons provided above, the examiner maintains the rejections of the claims as set forth below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota (JP 08340398) in view of Shintani et al (hereafter referred to as Shintani) (4992875).

(Claims 1, 5, 9) Ota discloses an image conversion system comprising a digital image generation means (11) that reads out an image on photographic film and generates a digital image signal representing the image, a format conversion means that converts the format of the digital image signal into a predetermined format used in a digital camera separate from the digital image generation means (Constitution lines 2-3), and an image signal recording means that records the digital image signal in the predetermined format on a recording medium (magnetic disk) (Constitution line 4). The predetermined format is that of JPEG format, which can inherently be used in the digital camera, since it is checked when the image data of the camera is not in that format (Constitution line 5). Ota does not specifically disclose the recording medium can be loaded in the digital camera.

Shintani discloses a still video camera that uses a magnetic disk as the recording medium that can be loaded in the camera (Col 4, Lines 4-11, 26-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the magnetic disk attaching portion disclosed by Shintani, wherein a magnetic disk can be loaded into a digital camera, such as the one disclosed by Ota, so the digital camera would not have to be limited to being attached to a computer, as illustrated by Ota (Fig 2), but could be used wherever the user desires to capture an image, and have its own memory storage device to store the images for later use.

(Claims 2, 6, 10) Ota further discloses the digital image generation means includes a film scanner (11) for reading an image from the photographic film as an analog signal, and an A/D converter for converting the analog signal to the digital image signal (Constitution line 1).

(Claims 3, 7, 11) Ota further discloses the format conversion means includes a color transformation means for converting the digital image signal into RGB digital image signals, and a format processor means for converting the RGB digital image signal into the predetermined

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format for the digital camera (Constitution lines 2-3). Although Ota does not specifically state the RGB color signals are 8-bit digital image signals, it is notoriously well known in the art that in an RGB color signal, each color is expressed in 8 bits.

(Claims 4, 8, 12) Ota further discloses control unit (32) as the user input means for allowing a user to designate the predetermined format for conversion of the digital image signal.

(Claims 15-17) Ota further discloses services provided exclusively for the digital camera are provided in that only data that is used in the digital camera is checked to see if the data is in JPEG format, and if not compression is canceled (see Constitution, lines 4-6).

4. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota in view of Shintani as applied to claim 1 above, and further in view of Fukushima et al (hereafter referred to as Fukushima) (US 6253023 B1).

The combined invention of Ota and Shintani discloses an image conversion system as discussed above, but does not specifically disclose format selecting means or recording medium selecting means for selecting a desired format and recording medium from a plurality of formats and recording media used in digital cameras.

Fukushima discloses a digital camera comprising format-selecting means that selects a desired format from a plurality of types of formats used for digital cameras (col 11, line 65 – col 12, line 7), and recording medium selecting means for selecting a desired recording medium from a plurality of types of recording media that can be loaded into a digital camera (col 12, lines 55-65; col 13, lines 11-21, 34-44; col 27, line 55 – col 28, line 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the format-selecting means and recording medium selecting means disclosed by Fukushima into the combined invention of Ota and Shintani since it is well known in the art that various types of recording medium can be loaded in a digital camera (as

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taught by Shintani) and the appropriate format for recording image data on the selected recording medium would have to be selected for the system to operate correctly.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tia M Harris whose telephone number is 703-305-4807. The examiner can normally be reached on M-F 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

tmh tmh
12/18/03



ANDREW CHRISTENSEN
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